

REMARKS

Claims 77-86 and 109-148 are pending in the current application. Applicants have amended independent claims 77, 109, 119, 128, and 137. No new matter has been added. Reexamination and reconsideration of all claims, as amended, is respectfully requested.

§ 103

The Office Action rejected claims 77, 80-86, 109, 112-116, 119, 122-125, 128, 130-134, 137-139, and 141-146, including independent claims 77, 109, 119, 128, and 137 under 35 U.S.C. § 103 based on Bylsma, U.S. Patent No. 6,319,220 (“Bylsma”) in view of Dotson, Jr., U.S. Patent No. 4,274,411 (“Dotson”). The Office Action rejected all other pending dependent claims also based on Dotson in view of Bylsma, but referencing Gonan, U.S. Patent 6,423,028 (“Gonan”) for certain claimed ranges/values.

Applicants have amended the independent claims of the present application and submits that these amendments distinguish the claims from the disclosure of Bylsma. For example, Applicants have amended claim 77 to read “applying a series of modulated differential pressure pulses to the ocular region via a fluid control device configured to deform aspiration tubing providing aspirating fluid from the ocular region, wherein the modulated differential pressure pulses comprise a substantially de minimis pressure differential pulse.” Similar amendments have been made to all other pending independent claims. Bylsma does not teach or suggest “applying a series of modulated differential pressure pulses . . . wherein the . . . pulses comprise a substantially de minimis pressure differential pulse”

Applicants further note that the word “modulate” or “modulated” is generally defined as “change or manipulate,” and “differential” means a difference between two values. A relatively constant flow as disclosed in Bylsma is not a “modulated differential” pressure pulse as claimed. For this further reason, the amended claims are not obvious based on Bylsma.

Dotson fails to make up for the deficiencies of Bylsma. Dotson does not teach or suggest “applying a series of modulated differential pressure pulses . . . wherein the . . . pulses comprise a substantially de minimis pressure differential pulse” as claimed. Dotson also does not teach or suggest deformation of aspiration tubing as claimed, but instead keeps all illustrated tubing intact and undeformed. *See, e.g.* Dotson, col. 3, lines 30-39 and lines 48-50 and col. 5, lines 18-29.

Combination of References

Applicants disagree that one of ordinary skill in the art would have a reason to combine the features disclosed in the Bylsma and Dotson references in the manner suggested in the Office Action. Dotson is solely relied on as purportedly showing inhibiting fluid flow and fails to teach or suggest deformation of tubing. Bylsma is relied on for its peristaltic pump and the ultrasonic limitations of the claims. Applicants submit that a combination of Bylsma and Dotson is unreasonable, and such a combination is using hindsight to reconstruct the claimed invention. As noted, neither Dotson nor Bylsma apply modulated differential pressure pulses to the ocular region by deforming the aspiration tubing providing aspiration fluid from the ocular region, wherein the modulated differential pressure pulses comprise a substantially de minimis pressure differential pulse. Bylsma does not discuss modulated differential pressure pulses, much less pulses that comprise a substantially de minimis pressure differential pulse, and thus would not be relied on to solve the problem currently solved by the present design.

The PTO has the burden of establishing a *prima facie* case of obviousness under 35 USC §103. The Patent Office must show that there is some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable

reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention.

None of the references, alone or in combination, teach the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. [*citation omitted*]

In re Gordon, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a *prima facie* case for obviousness. See, *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at "whether there was an apparent reason to

combine the known elements in the fashion claimed...,” citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” KSR at 14).

The reasoning supporting the combination is “to provide a system that aids in the aspiration of hard to remove pieces of material...” Office Action, p. 3. This is merely a conclusion used to justify choosing references based on aspects presented in the claims. It is always beneficial to improve operation, cost, efficiency, and so forth, but the question is what reasoning would have been used by one of skill to take the ultrasonic teachings of the Bylsma ultrasonic device and peristaltic pump and modify them in a manner consistent with the Dotson fluid design. Here, no such reason has been articulated. Conclusory reasoning such as that presented is improper hindsight reconstruction of the invention and for this further reason, claims 77, 109, 119, 128, and 137, as amended, and claims depending therefrom are allowable over the cited references.

Based upon the totality of the foregoing, Applicants respectfully submit that claims 77, 109, 119, 128, and 137, as amended, are allowable over the references of record, and all claims dependent therefrom are also allowable as they include limitations not present in the cited references .

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

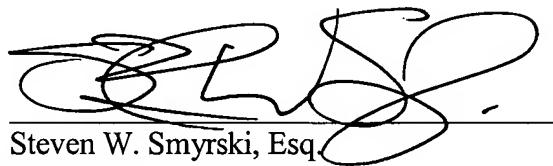
CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants believe that no fees are due in accordance with this Response. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502026.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Smyrski', is written over a horizontal line.

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